



02-23-05

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Practitioner's Docket No. DN 96-006 D1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: DRUMMOND

Application No.: 09/826,062

Group No.: 1731

Filed: 04/04/2001

Examiner: Peter Chin

For: THE USE OF CALCIUM CARBONATE IN AN ACIDIC AQUEOUS MEDIA

MAIL STOP PETITION

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

**PETITION TO THE COMMISSIONER FOR PATENTS
FOR REVIVAL OF AN APPLICATION UNINTENTIONALLY ABANDONED
AT NO FAULT OF THE APPLICANT**

Applicant would like to petition to the Commissioner for Patents to revive US Application Number 09/826,062, which was unintentionally abandoned by no fault of the Applicant. The following are the chronological occurrences that took place surrounding this application.

In addition, all documents referred to below are attached with this Petition for your review.

1. An Office Action (Paper Number 9) dated February 28, 2003 was sent to Applicant.
2. Applicant filed a response to this Office Action on July 21, 2003 along with a Petition and Fee for Extension of Time. This response was sent via Facsimile to number (703) 305-7718.
3. A Notice Of Abandonment dated October 3, 2003 was sent to Applicant for failure to timely file a proper reply to the Office Action dated February 28, 2003.
4. Applicant was not expecting to receive a Notice of Abandonment, so Michael J. Herman (Agent of Record) called Peter Chin (Examiner) on October 8, 2003. As a result of this conversation, Examiner Chin asked Mr. Herman to re-fax the response. The Response to the Office Action dated February 28, 2003 was re-faxed on October 8, 2003 to facsimile number (703) 305-7718.

5. This response was docketed as complete in our PC Master Database so no open action items appeared on our docket. It was our understanding the next action would be coming from Examiner Chin.
6. On January 24, 2005 the file was being reviewed for an unrelated issue and it came to our attention that we have not yet received another Office Action from Examiner Chin.
7. Applicant then went onto the USPTO web-site and checked the PAIR database for the application status which displayed that the application was abandoned on October 3, 2003 and no other actions had taken place.
8. Applicant faxed the Office Action response on two separate occasions and it was not received and processed either time.
9. Messages were then left for Examiner Peter Chin on January 25, 2005 and January 31, 2005.
10. Michael J. Herman (Agent of Record) finally spoke with Examiner Chin on Wednesday January 26, 2005 and Examiner Chin had instructed Applicant to file a Petition to the Commissioner explaining all of the facts surrounding the abandonment of this application as well as copies of all documentation. Examiner Chin had also suggested that the response may have been lost due to all the moving/changes occurring at the USPTO at that time.

No fee is believed due for the filing of this Petition. Should any fees be required, however, please charge such fees to Minerals Technologies Inc. Deposit Account No. 13-3639.

Date: 2/7/05


SIGNATURE OF PRACTITIONER

Reg. No.: 51,289
Tel. No.: (610) 861-4925

Michael J. Herman
1 Highland Avenue
Bethlehem, PA 18017
US



Office Action Summary

Application No.	09/826,062	96006	Applicant(s)	DRUMMOND, DONALD KENDALL
Examiner	Peter Chin		Art Unit	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Feb. 28, 2008
mailing date

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) 20, 21 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 17-19, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____



DETAILED ACTION

1. Claims 1, 19, 22, and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wu (5,647,902).

Wu discloses an aqueous acid stabilized CaCO_3 filler dispersion. The dispersion is stabilized by the addition of sodium carbonate and weak acids such as polyacrylic acid and phosphoric acid, column 3, last paragraph. The pH of the dispersion is below 7. The present claims by employing claim language "comprising" is open to the presence of sodium carbonate and thus the claimed invention is anticipated or at the least, obviously shown by Wu. In regard to claim 23, a claim directed to a method of chemically making the filler per se, this claim depends from a method of acid stabilizing a filler slurry. Therefore this claim is treated as a product by process of making the filler used in the claimed method of acid stabilizing the dispersion of the filler. The claimed CaCO_3 filler used is precipitated CaCO_3 filler and therefore does not patentably define over the precipitated CaCO_3 filler of Wu. In any case, the claimed method is conventional in the art for making precipitated CaCO_3 filler and thus, would have been obvious. If evidence is needed see Brahm et al (4,242,318)

2. Claim 17 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (5,647,902).

The claimed amount of weak acid would have been obvious optimization of the acid stabilization of the CaCO_3 filler dispersion or slurry.

3. Claims 20, 21 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no

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allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

4. Applicant's election with traverse of the Group I invention in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the invention not in itself used for coating plywood or brick walls. This is not found persuasive because as Applicant acknowledges calcium carbonate is useful as a component of coatings, albeit with other components. Therefore the filler can be used in other materially different processes. In any case Brahm et al (4,242,318) show that similar aqueous dispersions of CaCO_3 can be used in making paints, column 1.

The requirement is still deemed proper and is therefore made FINAL.

5. In order to correct the record, the Group II invention directed to a method of making paper and paper product is encompassed by claims 21 and 24 and not claims 22-24 as stated in the previous Office Action, Paper No.6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Chin whose telephone number is (703) 308-2046. The examiner can normally be reached on Monday through Friday.

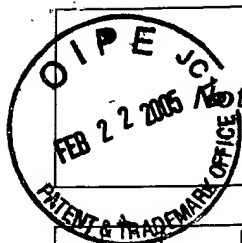
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Art Unit: 1731

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

A handwritten signature in black ink, appearing to read "Peter Chin", with a horizontal line extending from the end of the signature.

**PETER CHIN
PRIMARY EXAMINER**



Notice of References Cited

Application/Control No. 09/826,062		Applicant(s)/Patent Under Reexamination DRUMMOND, DONALD KENDALL	
Examiner Peter Chin		Art Unit 1731	Page 1 of 1

U.S. PATENT DOCUMENTS

* A	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	US-5,647,902	07-1997	Wu	106/464
	US-5,317,053	05-1994	Brown et al	106/465
	US-5,593,488	01-1994	wU	106/464
	US-5,043,017	08-1991	Passaretti	106/465
	US-4,242,318	12-1980	Brahm et al	12-1980
	US-			
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FOREIGN PATENT DOCUMENTS

* N	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification

NON-PATENT DOCUMENTS

* U	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,062	04/04/2001	Donald Kendall Drummond	96-006 D1	2444

7590 10/03/2003

Terry B. Morris
Minerals Technologies Inc.
One Highland Avenue
Bethlehem, PA 18017

EXAMINER

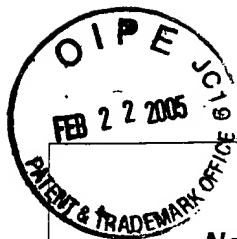
CHIN, PETER

ART UNIT PAPER NUMBER

1731

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



Notice of Abandonment

Application No.

09/826,062

Applicant(s)

DRUMMOND, DONALD
KENDALL

Examiner

Peter Chin

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

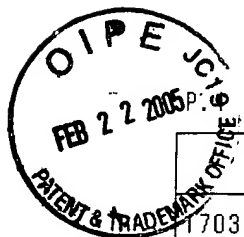
1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 28 February 2003.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

Peter Chin
Primary Examiner
Art Unit: 1731

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

** Transmit Conf. Report **

Oct 8 2003 9:05



Fax/Phone Number	Mode	Start	Time	Page	Result	Note
17033057718	NORMAL	8, 9:05	3'55"	17	* O K	

**FACSIMILE TRANSMITTAL**

MINERALS TECHNOLOGIES INC.
Intellectual Property Department
 One Highland Avenue
 Bethlehem, PA 18017
 Fax: (610) 861-7540

Date: October 8, 2003

To: USPTO - EXAMINER CHIN

Fax No.: 703 305 7718

From: Michael J. Herman

Phone No.: 610-861-4925

Total Pages (Including cover page) 17

Application No. 09/826,062 THE USE OF CALCIUM CARBONATE IN AN ACIDIC AQUEOUS MEDIA
 Our Ref.: DN 96-006 D1

Examiner Peter Chin,

Per our conversation of October 8, 2003, I am re-faxing our response and paperwork to the office action mailed February 28, 2003. Please contact me should you have any questions or concerns.

Thank you,

Michael J. Herman



FACSIMILE TRANSMITTAL

MINERALS TECHNOLOGIES INC.
Intellectual Property Department
One Highland Avenue
Bethlehem, PA 18017
Fax: (610) 861-7540

Date: October 8, 2003
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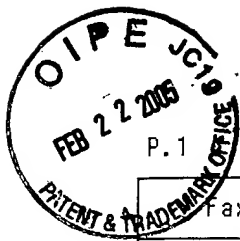
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Thank you,

Michael J. Herman

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THIS TRANSMISSION IS INTENDED ONLY FOR THE USE OF THE ADDRESSEE AND MAY CONTAIN INFORMATION THAT IS: 1. SUBJECT TO ATTORNEY/ CLIENT PRIVILEGE; 2. ATTORNEY WORK PRODUCT; OR 3. CONFIDENTIAL. IF YOU ARE NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THE INFORMATION CONTAINED IN THIS FACSIMILE IS STRICTLY UNAUTHORIZED AND PROHIBITED. IF YOU HAVE RECEIVED THIS FACSIMILE IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY COLLECT TELEPHONE CALL TO THE SENDER NAMED ABOVE. THANK YOU.



Fax:6108617540

**** Transmit Conf. Report ****

Jul 21 2003 10:56

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17033057718	NORMAL	21,10:56	3'43"	16	* O K	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DN 96-006 D1 ✓
MJP/MJH

In re application of:

Donald K. Drummond :

Application No.: 09/826,062 ✓ : Group No.: 1731

Filed: 04/04/2001 : Examiner: Peter Chin

For: THE USE OF CALCIUM CARBONATE IN AN ACIDIC AQUEOUS MEDIA

Assistant Commissioner for Patents
Washington, DC 20231

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following papers are being facsimile transmitted to the Patent and Trademark Office at (703) 305-7718 on the date shown below:

PETITION AND FEE FOR EXTENSION OF TIME – in duplicate
AMENDMENT TRANSMITTAL
AMENDMENT – 9 PGS.

Date: July 21, 2003

Andrea I. Rennig


Signature



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

96-006 D1
MJP/MJH

In re application of:

Donald K. Drummond :

Application No.: 09/826,062 : Group No.: 1731

Filed: 04/04/2001 : Examiner: Peter Chin

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Assistant Commissioner for Patents
Washington, DC 20231

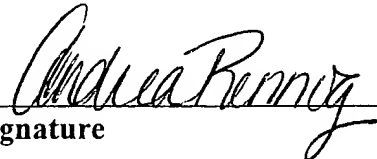
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Andrea I. Rennig


Signature